

REMARKS

Claims 11, 25, 28, and 29 are all the claims presently pending in the present application, as claims 1-10, 12-24, 26, and 27 are canceled. Claims 23, 25, 26, and 28 are rejected under 35 U.S.C. § 101 because the claimed invention allegedly is directed to non-statutory subject matter. Claims 2, 3, 5-8, 10, 13, 23, 25, 26, and 28 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Montero (US Patent No. 6,133,912).

§101 Rejections - Claims 23, 25, 26, and 28

In response to the rejections of claims 25 and 28 under 35 U.S.C. § 101, Applicants submit that claims directed to computer readable recording medium and a program data signal which is embodied in a carrier wave are statutory subject matter. The U. S. Patent and Trademark Office has provided that a carrier wave claim can be statutory subject matter. *See Examination Guidelines for Computer Related Inventions, (March 1996)*. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. § 101 are respectively requested.

§102(e) Rejections (Montero) - Claims 2, 3, 5-8, 10, 13, 23, 25, 26, and 28

Claims 2, 3, 5-8, 10, 13, 23, 25, 26, and 28 are rejected for the reasons set forth on pages 3-6 of the present Office Action.

A brief description of the new applied reference is as follows.

Montero

Montero is directed to a technique and apparatus for delivering information to the subscribers (terminals) on a communication network. The information is simultaneously displayed without interfering with the reception and/or display of subscribers' selected data or

program. *See Abstract.* An object of the invention of Montero is to provide a technique for targeting information to subscribers who are more likely to be interested in a particular information and delivering that information to only those targeted (selected) subscribers. *See column 2, lines 66 through column 3, line 3.*

With respect independent claim 25, Applicants submit that Montero does not disclose or suggest at least:

reads out information corresponding to the request and provides the read information to said at least one client device, without sending the request to said server device through the network, when it is determined that the requested information is stored in said information storage means, and

sends the request to said server device through the network, and controls said information providing means to transmit the requested information, when determined that the requested information is not stored in said information storage means.¹ *See claim 25.*

That is, nowhere does Montero disclose the specific conditional operations as set forth above (see underlined portions). At least based on the foregoing, Applicants submit that Montero does not anticipate claim 25. Applicants submit that claim 28 is patentable at least based on reasons similar to those set forth above with respect to claim 25.

§103(a) Rejections (Montero) - Claims 11, 12, and 29

With respect to claims 11 and 29, the Examiner acknowledges that Montero does not explicitly satisfy the features set forth in these claims, however the Examiner alleges that since Montero discloses keeping track of all requests and interactions, and keeping this information in a database, it would have been obvious for one of ordinary skill in the art at the time of the

¹ Claim 25 is amended, as indicated herein, for clarification purposes.

invention to include counting means for counting a number of client devices for the purpose of keeping track of subscribers' usage and being able to develop a more precise profile for subscribers. *See page 7 of Office Action.* In response, Applicants submit that the Examiner has utilized impermissible hindsight reasoning in determining that the specific features set forth in claims 11 and 29 would have been obvious to one skilled in the art. This specific feature of counting a number of client devices which have sent a request for transmission of information or a number of client devices to which the information sending means has sent requested information, according to the classification of the information, is nowhere disclosed or suggested in Montero. Thus, even if, *arguendo*, Montero indicates that it keeps track of all client interactions and requests for the purpose of developing more precise profile for subscribers, the specific features of claims 11 and 29 are clearly not set forth in Montero. Therefore, at least based on the foregoing, Applicants submit that claims 11 and 29 are patentably distinguishable over Montero.

§103(a) Rejections (Montero/Logue) - Claims 4 and 20-22

Claims 4 and 20-22 are canceled, as indicated herein, without prejudice or disclaimer.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

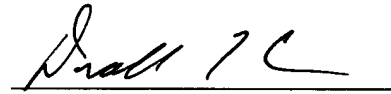
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AMENDMENT UNDER 37 C.F.R. § 1.111
U. S. Application No. 09/717,019

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Respectfully submitted,



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